

REMARKS

At the time of the First Office Action dated June 24, 2008, claims 1, 9, and 13 were pending and rejected in this application.

CLAIM 1 IS REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On page 2 of the First Office Action, the Examiner asserted that claim 1 is indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is respectfully traversed.

Specifically, on page 2 of the First Office Action, the Examiner asserted the following with regard to claim 1:

The term "article of manufacture" as a statutory class for the current invention is misleading. The appropriate classification for the claimed invention would be an apparatus.

Applicants respectfully disagree with the Examiner's analysis.

At the outset, it is Applicants who determine how to claim the invention. With regard to the Examiner's assertion regarding "article of manufacture," Applicants note that a device is a subset of an article of manufacture, since devices are articles that are manufactured. Thus, a claim to an article of manufacture can also be a claim to a device. Notwithstanding, Applicants note that the claimed is directed to a computer storage medium, which is a commonly claimed as an article of manufacture.

Turning to the specifics of the rejection, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of indefiniteness under the second paragraph of 35 U.S.C. § 112. M.P.E.P. § 2173.02 states the following:

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. (emphasis added).

As stated in Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings,¹ "[o]nly when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite." Applicants' position is that one having ordinary skill in the art would have no difficulty understanding the scope of claim 1, particularly when reasonably interpreted in light of the written description of the specification.² Therefore, for the reasons presented above, the imposed rejection of claim 1 under the second paragraph of 35 U.S.C. § 112 has been overcome, and hence, Applicants respectfully solicit withdrawal thereof.

CLAIMS 1, 9, AND 13 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON PITRODA, U.S. PATENT NO. 5,884,271 (HEREINAFTER PITRODA)

On pages 2-4 of the First Office Action, the Examiner asserted that Pitroda discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single

¹ 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004).

² In re Okuzawa, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

reference.³ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.⁴ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.⁵ This burden has not been met.

Upon reviewing the Examiner's cited passages, Applicants note the teaching of a transaction memory area 410 that stores, in electronic form, transaction receipts (see column 12, lines 21-24; column 10, lines 30-32; column 11, lines 4-7, 24-26). Pitroda also describes that the transactions can be downloaded to a home/office PC or stored in a main central computer of the card company (column 12, lines 24-26; column 11, lines 7-9). However, with the exception of discussing that these transactions can later be analyzed, Pitroda discusses little else with regard to the receipts.

Referring to claims 9 and 13, absent from the Examiner's cited passages are teachings regarding (i) locating a specific electronic receipt stored within the data store which corresponds to an identifier provided by the individual one of the multiple disparate vendors, and (ii) transmitting the located specific electronic receipt to the individual one of the multiple disparate

³ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

⁴ See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

⁵ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

1 vendors over the established communicative link. Also, although Pitroda teaches authenticating
2 the user of the UET card, the Examiner's cited passages fail to teach that the "individual one of
3 the multiple disparate vendors" is authenticated, as claimed. Claim 1 recites similar limitations
4 to those found in claims 9 and 13 and is patentable over Pitroda for similar reasons to those
5 presented above.

6
7 Applicants, therefore, respectfully submit that the imposed rejection of claims 1, 9 and 13
8 under 35 U.S.C. § 102 for anticipation based upon Pitroda is not viable, and hence, Applicants
9 solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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